

REMARKS

In an Office Action mailed on January 15, 2004, claims 34-51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's alleged Admitted Prior Art (APA) in view of Wold. Limitations from claims 43 and 50 have been incorporated into independent claims 34 and 44, respectively. Therefore, the § 103 rejections of claims 43 and 50 are specifically addressed below in the discussion of independent claims 34 and 44. Claims 43 and 50 have been cancelled.

Rejections of Claims 34-42:

As amended, the method of independent claim 34 recites installing the operating system package on the computer based on the information in the second configuration file; and the method includes patching errors in the first configuration file with information in the second configuration file.

In the rejection of previously-presented dependent claim 43 (now cancelled), the Examiner takes Official Notice and states that "patching of errors in a first configuration file with information in a second configuration file is well known in the art." Office Action, 5. The Examiner, on this basis, rejects claim 43 under section 103.

A *prima facie* case of obviousness requires more than the existence of all claim elements. More specifically, in order to establish a *prima facie* case of obviousness for claim 34, the Examiner must show that one skilled in the art, *without knowledge of the claimed invention*, would have modified Wold to derive the invention that is set forth in claim 34. However, the Examiner has not shown where the prior art contains this alleged suggestion or motivation, and therefore, fails to establish a *prima facie* case of obviousness. Although the Examiner takes Official Notice of the existence of patching errors in a first configuration with information in a second configuration file, the Examiner fails to show where the prior art teaches or suggests modifying Wold so that its script file contains information to patch errors in a configuration file that is external to Wold's operating system package. Therefore, for at least this reason, allowance of independent claim 34 is requested.

Additionally, Applicant challenges the Official Notice taken by the Examiner regarding the limitations that appear in previously-presented claim 43. The Examiner refers to the alleged

level of skill in the art but fails to show where the prior art allegedly teaches or suggests patching errors in a first configuration file with information in a second configuration file. Thus, Applicant requests the Examiner to provide either an affidavit attesting to the Examiner's personal knowledge to such a teaching or produce a reference that shows that the teaching is well known in the art. M.P.E.P. § 2144.03. Applicant notes that, "rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment." *Al-Site Corp. v. VSI Int'l, Inc.*, 50 USPQ2d 1161, 1171 (Fed. Cir. 1999). Thus, for at least the additional, independent reason that the Examiner fails to show where the prior art teaches all claim limitations, a *prima facie* case of obviousness has not been established for the limitations that appear in amended claim 34. Thus, for at least the reasons set forth above, allowance of independent claim 34 is requested.

To the extent the Examiner is taking Official Notice to the alleged suggestion or motivation, Applicant requests a reference to show that the suggestion or motivation is well known in the art or an affidavit from the Examiner attesting to the Examiner's personal knowledge of the alleged suggestion or motivation. M.P.E.P. § 2144.03.

Claims 35-42 are patentable for at least the reason that these claims depend from an allowable claim. Therefore, Applicant requests allowance of claims 34-42.

Rejections of Claims 44-49 and 51:

As amended, the article of independent claim 44 includes at least one computer readable storage medium that stores instructions to cause a computer to install an operating system package on the computer based on the information in an external configuration file. The instruction also cause the computer to patch errors in an internal configuration file with information in the external configuration file.

See discussion of independent claim 34 above. In particular, the Examiner rejects claim 50, whose limitations now appear in amended claim 44, on the premise that patching errors in a first configuration file with information in a second configuration file is allegedly well known in the art. As pointed out above, even assuming, *arguendo*, that this is true, the Examiner fails to show where the prior art contains the alleged suggestion or motivation that would have led one skilled in the art, *without knowledge of the claimed invention*, to modify Wold so that Wold's

script file contains patch information for an internal configuration file of an operating system package. Thus, for at least the reason that the Examiner has failed to show where the prior art contains this alleged suggestion or motivation, withdrawal of the § 103 rejection of independent claim 44 is requested.

Additionally, Applicant challenges the Official Notice by the Examiner and requests the Examiner to either produce a reference that shows that patching of errors in a first configuration file with information in a second configuration file is well known in the art or provide an affidavit attesting to the Examiner's personal knowledge of such a teaching. M.P.E.P. § 2144.03. Otherwise, amended claim 44 is patentable for at least this additional, independent reason that no art cited by the Examiner teaches or suggests the claim limitations that appear in this claim.

To the extent the Examiner is taking Official Notice to the alleged suggestion or motivation, Applicant requests a reference to show that the suggestion or motivation is well known in the art or an affidavit from the Examiner attesting to the Examiner's personal knowledge of the alleged suggestion or motivation. M.P.E.P. § 2144.03.

Thus, amended independent claim 44 overcomes the § 103 rejection. Claims 45-49 and 51 are patentable for at least reason that these claims depend from an allowable claim.

Rejections of Claims 36-42, 45-49 and 51:

The Examiner primarily relies on "Official Notice" to reject claims 36-42, 45-49 and 51. Applicant challenges the Official Notice for each one of these claims and requests the Examiner to either produce a reference that shows that these limitations are well known in the art or an affidavit attesting to the Examiner's personal knowledge of these limitations. M.P.E.P. § 2144.03. Otherwise, for at least this reason, withdrawal of these § 103 rejections is requested. Furthermore, even assuming, *arguendo*, that one or more of these limitations are well known in the art, the Examiner fails to show where the prior art contains the alleged suggestion or motivation to modify the cited references to derive the missing claim limitations. To the extent the Examiner is taking Official Notice to the alleged suggestion or motivation for any of these claims, Applicant requests a reference to show that the suggestion or motivation is well known in the art or an affidavit from the Examiner attesting to the Examiner's personal knowledge of the

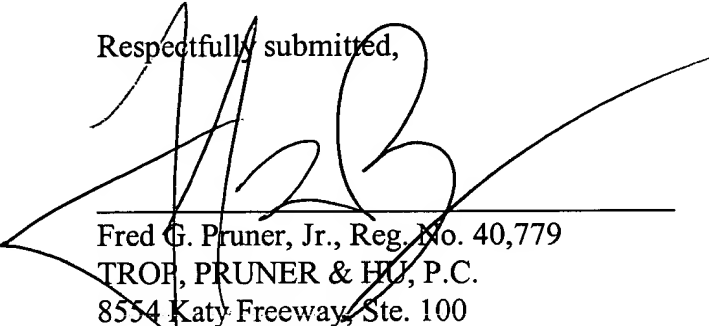
alleged suggestion of motivation. M.P.E.P. § 2144.03. Therefore, for at least any of the reasons stated above, withdrawal of the § 103 rejections of claims 36-42, 45-49 and 51 is requested.

CONCLUSION

In view of the foregoing, withdrawal of the § 103 rejections and a favorable action in the form of a Notice of Allowance are requested. The Commissioner is hereby authorized to charge any additional filing fees required under 37 C.F.R. 1.16 and 1.17 and/or credit any overpayments to Deposit Account No. 20-1504 (MCT.0126US).

Respectfully submitted,

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